



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

NW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/851,040	05/05/97	VISSER	B 17342-000500

PM82/0925
TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

PM82/0925

EXAMINER	
CHILCOT, R	
ART UNIT	PAPER NUMBER
3635	21

DATE MAILED: 09/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	08/851,040	VISSER, BARNEY D.	
	Examiner Richard E. Chilcot, Jr.	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) Responsive to communication(s) filed on 17 July 2000.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4, 6-16, 18-26 and 28-36 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-4, 6-16, 18-26 and 28-36 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:
 1. received.
 2. received in Application No. (Series Code / Serial Number) _____.
 3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- | | |
|---|---|
| 14) <input type="checkbox"/> Notice of References Cited (PTO-892) | 17) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 15) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 18) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 16) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 19) <input type="checkbox"/> Other: _____ . |

Art Unit: 3635

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-26 and 28-36 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21-26 and 28-36 are directed to non-statutory subject matter; and in particular, these claims are directed to a method of doing business. As can be seen theses claims, there are limitations which require a human to visualize how products are displayed in order for the human to be enticed to purchases a particular item. Also a key element in these claims requires the thought process of a human to select a particular store based upon a facility layout. Clearly, the inclusion of the human thought process in the method of doing business fails to fall within the safe harbors of business methods defined in MPEP sections §§ 706.03(a), 2105, 2106 – 2106.02 and 2107 – 2107.02.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-16, 18-26 and 28-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Searcy.

Art Unit: 3635

Each storeroom (64, 66, 116) is a separate store by itself, separating walls (22, 24, 68, 70, 80, 120, 124), aisle is the space that enables walking through; outside entrances (A, B, C). The single door is equivalent to the double doors. Different personnel would manage each store (room) as commonly done in most department stores such as Macy's, Nordstrom, Bloomingdale's, and etc.

Also, the examiner takes Judicial Notice that most contemporary malls constructed today (an example has been provided in the map of Tyson Corner Center) have a system for facilitating the presentation of inventory items. The contemporary malls comprise at least three separate stores, such as the large anchor stores at each end of the mall, an elongated wall separating each store and doorways aligned with each other so that a person standing in the corridor between each store, a person could see a portion within each store.

Furthermore, the examiner takes Judicial Notice that in many malls such as Potomac Mills, Tyson Corner, Pentagon City Mall, located in Northern Virginia, there are separate stores (with orthogonal walls and distinct entrances) each specializes in one type of merchandise, such as furniture, clothing, toys etc.

Response to Arguments

Applicant's arguments filed July 17, 2000, have been fully considered but they are not persuasive. Applicant argues that § 101 rejection is without merit and that the safe harbors of business methods are irrelevant. The examiner is of another opinion. While it is agreed the present invention does not fall within the business method

Art Unit: 3635

guidelines and the "safe harbors" appear to be irrelevant, the examiner was merely pointing out to applicant the only acceptable business method claims. It is quite clear that the present claims do not relate to a computer algorithm. However, the claims do recite a business method which requires the manipulation of a human thought process, which is not permissible under 101. Specifically, the presentation of articles for sale falls within marketing techniques. For example, when a new product is available to the public, a marketing campaign is launched. This includes numerous ads and store displays which prominently locates the item for sale. This is all that applicant is claiming in the aforementioned claims. Applicant is reciting a typical mall environment which has numerous adjacent stores. The interiors and some of the products of these stores are generally visible to a person; however, to entice a person to enter the store, select a product and purchase a product falls within the manipulation of a human thought process. Accordingly, these claims fail to define statutory subject matter.

The examiner's arguments regarding the anticipation of the claims, as set forth in the Final Office action dated August 20, 1999, are incorporated herein.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3635

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard E. Chilcot, Jr. whose telephone number is (703) 305-4716. The examiner can normally be reached on Monday through Friday from 6:30 am to 4:00 pm EST. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman, can be reached on (703) 308-0839. The fax phone number for the organization where this application or proceeding is assigned is (703).08-3687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1020.



Richard E. Chilcot, Jr.
Primary Examiner
Art Unit 3635